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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,712	11/08/2001	Richard A. Morris	020431.1081	4170
53184 7590 04/16/2007 i2 TECHNOLOGIES US, INC. ONE i2 PLACE, 11701 LUNA ROAD DALLAS, TX 75234			EXAMINER FERNANDEZ RIVAS, OMAR F	
			ART UNIT 2129	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/035,712

Applicant(s)

MORRIS ET AL.

Examiner

Omar F. Fernández Rivas

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-11, 13-21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-11, 13-21 and 23-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to an amendment filed on March 19, 2007.
2. The Office Actions of July 28, 2004, January 4, 2005, July 14, 2005, February 23, 2006, July 26, 2006 and December 19, 2006, are fully incorporated into this Final Office Action by reference.

### **Status of Claims**

3. Claims 2, 13 and 23 have been amended. Claims 2-11, 13-21 and 23-31 are pending on this application.

### ***Claim Objections***

4. In light of the amendments made on claims 2, 13 and 23, the objection from the previous Office Action has been withdrawn.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-11, 13-21 and 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberg et al in view of Schumacher et al. (US Patent #6,587,969, referred to as **Weinberg**; US Patent #6,532,023, referred to as **Schumacher**).

**Claims 2, 13 and 23**

Weinberg teaches a method, a system and software for reproducing a selection of members in a hierarchy, the method performed using a computer system comprising one or more processing units and one or more memory units (**Weinberg**: Abstract, L6-15; C2, L32-56; Figs. 3A, 3B, 4B and 4D; Examiner's Note (EN): a tree is a hierarchy, nodes are members of the tree. Playing back the recorded user's steps is reproducing the selection of members in the hierarchy), the method comprising: providing a member selection interface to a user, the member selection interface capable of providing the user with the ability to navigate through a hierarchy of members (**Weinberg**: Abstract, L6-15; C2, L32-56; C5, L52-59; C26, L4-19; Figs. 3A, 3B, 4B and 4D; EN: displaying the test as a tree having nodes (members) is providing a member selection interface. Editing nodes (members) on the tree is navigating through the hierarchy of members); receiving input of a user from a member selection interface (**Weinberg**: Abstract, L8-15; C2, L41-56; C5, L52-59; C26, L4-19); determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, the hierarchy of members being associated with a particular dimension of an organization of data (**Weinberg**: Abstract; C2, L41-56, C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: selecting nodes (members) that correspond to a particular field or object (dimension of an organization of data). A particular server screen is also a dimension of an organization of data. Recording the series of user's steps (actions) is determining a sequence of actions associated with the tree).

Weinberg does not teach recording the sequence of actions of the user in a member selection script, the member selection script including a hierarchy selection command for determining the sequence of actions to be recorded; and executing the recorded member selection script, after the hierarchy of members has been modified, to reproduce the users original input to the member selection interface, based upon the members and hierarchical relationships of the users original inputs from the member selection interface.

Schumacker teaches recording the sequence of actions of the user in a member selection script, the member selection script including a hierarchy selection command for determining the sequence of actions to be recorded (**Schumacher**: abstract; C1, L47-53; C2, L12-29; C4, L10-67; C6, L11-35; Fig. 9; EN: the automator events listeners will provide the commands to record the user's interactions (sequence of actions). The automator queue is a script as understood from page 16, lines 21-23 of the specification of the present application); and executing the recorded member selection script, after the hierarchy of members has been modified, to reproduce the users original input to the member selection interface, based upon the members and hierarchical relationships of the users original inputs from the member selection interface (**Schumacher**: abstract; C2, L12-60; C5, L20-57; C7, L6 to C8, L5; EN: emulating the original user's interaction sequence (user's original inputs) from the queued event objects (script). The constructed event object will provide the hierarchical relationships of the user's inputs).

It would have been obvious to one of ordinary skill in the arts at the time of the applicant's invention to modify the teachings of Weinberg by incorporating recording the

Art Unit: 2129

sequence of actions of the user in a member selection script, the member selection script including a hierarchy selection command for determining the sequence of actions to be recorded; and executing the recorded member selection script, after the hierarchy of members has been modified, to reproduce the users original input to the member selection interface, based upon the members and hierarchical relationships of the users original inputs from the member selection interface as taught by Schumacher for the purpose of having a system that can save the user time since it can recreate the user's interactions and provide results without requiring the user's input each time the system is used.

**Claims 3, 14 and 24**

Weinberg teaches one or more of the actions comprise selecting the dimension from which members are to be selected, the dimension selected from the group consisting of a product dimension, a geography dimension, and a time dimension (**Weinberg**: Abstract, L12-15; C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: selecting the screen objects or fields is selecting the dimensions).

**Claims 4, 15 and 25**

Weinberg teaches one or more of the actions comprise selecting the hierarchy from which members are to be selected (**Weinberg**: Abstract, L12-15; C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: selecting the screen objects or fields is selecting the hierarchy).

Art Unit: 2129

**Claims 5, 16 and 26**

Weinberg teaches selecting or deselecting one or more levels of the hierarchy from which members are to be selected, the members being selectable only from selected levels (**Weinberg**: C3, L14-20; C9, L7-16; C17, L1-26 Figs. 2, 3A, 3B, 4B, 4D, 5D, 5F; EN: nodes on a tree can only be selected in levels depending on their location in the hierarchy).

**Claims 6, 17, and 27**

Weinberg teaches expanding a member to view the children of the member; and the selection of an expanded member causing only the selection of the expanded member (**Weinberg**: C9, L1-16; C17, L1-26; Figs. 3A, 3B, 4B, 4D, 5E).

**Claims 7, 18 and 28**

Weinberg teaches collapsing a member to hide the children of the member; and the selection of a collapsed member causing the selection of the expanded member and the children of the expanded member (**Weinberg**: C9, L1-16; C17, L1-26; Figs. 3A, 3B, 4B, 4D, 5E).

**Claims 8, 19 and 29**

Weinberg teaches selecting or deselecting one or more members from the hierarchy (**Weinberg**: Abstract, L12-15; C3, L11-23; C9, L1-16; C17, L1-26; Figs. 3A, 3B, 4B, 4D, 5E).

**Claims 9, 20 and 30**

Weinberg teaches the one or more actions are recorded in the member selection script using one or more commands, the commands and one or more parameters

Art Unit: 2129

associated with each command identifying the one or more actions (**Weinberg**:

Abstract, L1-3; C2, L23-56; C21, L22-65; Figs. 6A, 6B, 6C).

#### **Claim 10**

Weinberg teaches the user manually generates the member selection script (**Weinberg**: Abstract, L1-3; C2, L23-56; C5, L27-31; C25, L20-49; Fig. 1; EN: if the user is making selections, he is manually generating the script or protocol to follow).

#### **Claims 11, 21 and 31**

Weinberg teaches the member selection script is automatically generated based on input received from the user using a member selection interface (**Weinberg**: C21, L22-67, C22, L 1-36; Figs. 6A, 6B, 6C).

#### **Response to Applicant's arguments**

7. The Applicant's arguments have been fully considered but are not persuasive. The Examiner notes that some of these arguments were addressed in the Non-Final Office action of December 19, 2006 and no new arguments have been provided by the Applicant to the Examiner's responses.

#### **In reference to Applicant's arguments:**

The Applicants respectfully submit that Weinberg fails to disclose, teach, or suggest independent Claim 2 limitations regarding a "computer-implemented method for reproducing a selection of members in a hierarchy" and in particular Weinberg fails to disclose, teach, or suggest independent Claim 2 limitations regarding "providing a member selection interface to a user, the member selection interface capable of providing the user with the ability to navigate through a hierarchy of members". In particular, the Examiner equates "providing a member selection interface to a user" recited in independent Claim 2, with "displaying the test as a tree" disclosed in Weinberg. (19 December 2006 Office Action, Page 3). However, "displaying the test as a tree" disclosed in Weinberg merely represent steps of the test, and does not include, involve, or even relate to providing a member selection interface to a user, as recited in independent Claim 2: (Abstract). In contrast, the present invention provides a "member



selection interface to a user' wherein the "member selection interface [is] capable of providing the user with the ability to navigate through a hierarchy of members". Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between Weinberg and independent Claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 2 from Weinberg.

**Examiner's response:**

Paragraph 11 applies. As stated in the rejection above, the system of Weinberg displays the test to the user as a tree having nodes (**Weinberg**: abstract, L6-8; C2, L41-48; Figs 3A, 3B, 4B and 4D). The user can select nodes in the tree to perform editing operations on the test (**Weinberg**: abstract, L8-12; C2, L41-48; C5, L52-59; Figs 3A, 3B, 4B and 4D). The limitations cited by the Applicant are taught by the Weinberg reference since it teaches displaying (providing) the test (interface) to the user as a tree having nodes (members of the tree or test) that can be selected (or navigated) by the user (the user can select members from the tree or the test). The Applicant's attention is directed to page 15, L3-17 of the specification of the present application where it describes trees, nodes and members of a hierarchy. Moreover, one needs only look at figure 4 of the present application, which is an example of a member selection interface, and figures 3A, 3B, 4B and 4D of Weinberg to see that, while not identical, the test displayed to the user is a member selection interface as claimed by Applicant.

**In reference to Applicants arguments:**

The Applicants further respectfully submit that Weinberg fails to disclose, teach, or suggest independent Claim 2 limitations regarding "receiving input of the user from the member selection interface". In particular, the Examiner equates "receiving input of the user from the member selection interface" recited in independent Claim 2 with "the user interface" disclosed in Weinberg. (19 December 2006 Office Action, Page 3).

However, the user interface disclosed in Weinberg is merely a user interface of a testing tool that allows the user to define verification steps to automatically test for expected server responses during test execution, and does not include, involve, or even relate to a member selection interface, as recited in independent Claim 2. (Abstract). In contrast, and as discussed above, the "member selection interface" recited in independent Claim 2 provides a user with the ability to navigate through a hierarchy of members and select particular members the user desires for a particular function.

**Examiner's response:**

Paragraph 11 applies. The user can select (navigate through the nodes) and edit nodes (members) in the test displayed (the member selection interface) (**Weinberg**: abstract, L8-12; C5, L52-59). If the user is selecting and editing the nodes, then input from the user is being received through the test displayed (member selection interface).

**In reference to Applicant's arguments:**

The Applicants still further respectfully submit that Weinberg fails to disclose, teach, or suggest independent Claim 2 limitations regarding "determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from the hierarchy of members, the hierarchy of members being associated with a particular dimension of an organization of data". In particular, the Examiner equates "the hierarchy of members being associated with a particular dimension of an organization of data" recited in independent Claim 2 with the server screen disclosed in Weinberg. (19 December 2006 Office Action, Page 3). However, the server screen disclosed in Weinberg is merely a separate window that is displayed to the user and has nothing to do with a particular dimension of an organization of data, as recited in independent Claim 2. (Column 3, Lines 11-36). In contrast, "the hierarchy of members being associated with a particular dimension of an organization of data" recited in independent Claim 2 allows a user to select a particular data dimension from which members are to be selected and may include, but is not limited to, a product dimension, a geography dimension, and a time dimension. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between Weinberg and independent Claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 2 from Weinberg.

Art Unit: 2129

**Examiner's response:**

Paragraph 11 applies. As stated in the rejection above, the Examiner considers that if the user is selecting nodes (members) that correspond to a **particular field or object (Weinberg: abstract, L12-15)**, then he is selecting from a particular dimension of data. Moreover, each particular server screen can be considered a particular dimension of data, since each screen will display a different set of objects depending on the test. Moreover, the tree presented to the user is structured in a hierarchical manner so as to indicate interrelations between the steps and the screens that are part of the business process (**Weinberg: C11, L34-50**), therefore the hierarchy of members is associated with a particular dimension of an organization of data (the business process being tested).

**In reference to Applicant's arguments:**

The Applicants respectfully submit that Schumacher fails to disclose, teach, or suggest independent Claim 2 limitations regarding "recording the sequence of actions of the user in a member selection script, the member selection script including a hierarchy selection command for determining the sequence of actions to be recorded". In particular, the Examiner equates "recording the sequence of actions" recited in independent Claim 2, with "applet event recorder" disclosed in Schumacher. (19 December 2006 Office Action, Page 4). However, the "applet event recorder" disclosed in Schumacher merely places listeners on each component of the applet, but does not include, involve, or even relate to recording the sequence of actions, as recited in independent Claim 2. (Column 2, Lines 12-29). For example, the "applet event recorder" in Schumacher merely emulates the user interaction sequence but fails to teach, suggest, or even hint at providing a hierarchy selection command for determining the sequence of actions to be recorded, as recited in independent Claim 2. (Column 6, Lines 1-10). Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between Schumacher and independent Claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 2 from Schumacher.

**Examiner's response:**

Paragraph 11 applies.

Regarding the argument relating to recording the sequence of actions, Shumacher teaches a system for recording events resulting from user interactions with an applet. When a sequence of interactions (actions) with the applet occurs, the events (actions of the user) are stored in a queue (the script) (**Shumacker**: abstract; C1, L50-53; C4, L57 to C5, L19; C6, L11-35; Fig. 1).

Regarding the argument relating to a hierarchy selection command for determining the sequence of actions to be recorded, Shumacher teaches that one or more types of events (sequence of actions) are selected for recording via the recording options (the hierarchy selection command) in the user interface. When an event of the selected type is detected, it is recorded (**Shumacker**: abstract; C5, L20-57).

**In reference to Applicant's arguments:**

The Applicants further respectfully submit that Schumacher fails to disclose, teach, or suggest independent Claim 2 limitations regarding "executing the recorded member selection script, after the hierarchy of members has been modified, to reproduce the users original input to the member selection interface, based upon the members and hierarchical relationships of the users original inputs from the member selection interface". Schumacher does not teach, suggest, or even hint at executing this sequence of events (actions) once the hierarchy is modified and thereafter produce a new selection of members that satisfies the user's original intent, based upon the members and hierarchical relationships of the users original inputs from the member selection interface.

**Examiner's response:**

Applicant cannot show non-obvious by attacking the references individually where as here the rejections are based on a combination of references see In re Keller USPQ 871 (CCPA 1981). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures.

The system of Weinberg teaches displaying a test to a user as a tree having nodes. The user is able to select nodes in the tree to edit the test. Weinberg teaches a system for recording user interactions with an applet and playing back the interactions recorded. By combining the teachings of Weinberg and Shumacker, the limitations cited above by the applicant are taught by the combination. As an example, the system of Weinberg could be implemented as an applet containing the recording and playback features taught by Shumacker. Moreover, Weinberg teaches for recording the user's interactions with the user interface and playing back the recorded steps (**Weinberg**: C2, L23-40; C8, L39 to C9, L18).

**In reference to Applicant's arguments:**

Thus, Schumacher cannot provide for "executing the recorded member selection script, after the hierarchy of members has been modified, to reproduce the users original input to the member selection interface, based upon the members and hierarchical relationships of the users original inputs from the member selection interface", since Schumacher does not even provide for (1) recording the sequence of events (actions) that the user went through to determine the members that are selected; or (2) executing this sequence of events (actions) once the hierarchy is modified and thereafter produce a new selection of members that satisfies the user's original intent. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between Schumacher and independent Claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are

Art Unit: 2129

sufficient to patentably distinguish independent Claim 2 from Schumacher.

**Examiner's response:**

Paragraph 11 applies. These arguments have been addressed above.

**In reference to Applicant's arguments:**

The Applicants respectfully submit that the Office Action fails to properly establish a prima facie case of obviousness based on the proposed combination of Weinberg or Schumacher, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one of ordinary skill in the arts at the time of the applicant's invention to modify the teachings of Weinberg by incorporating recording the sequence of actions of the user in a member selection script". (19 December 2006 Office Action, Page 5). (Emphasis Added). The Applicants respectfully disagree.

The Applicants further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in Weinberg or Schumacher, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed "for the purpose of having a system that can save the user time since it can recreate the user's interactions and provide results without requiring the user's input each time the system is used." (19 December 2006 Office Action, Page 5). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does "provid[ing] results without requiring the user's input" directly "save the user time" and to what extent does the Examiner purport that "recreat[ing] the user's interactions" applies to the subject Application.

The Applicants respectfully request the Examiner to point to the portions of Weinberg or Schumacher which contain the teaching, suggestion, or motivation to combine these references for the Examiner's stated purported advantage. In particular, the Applicants respectfully request the Examiner to point to the portions of Weinberg or Schumacher which expressly states that "recreat[ing] the user's interactions" equates to "executing the recorded member selection script, after the hierarchy of members has been modified, to reproduce the user's original input to the member selection interface, based upon the members and hierarchical relationships of the user's original inputs from the member selection interface", as recited in independent Claim 2. The Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

Art Unit: 2129

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Weinberg or Schumacher to render obvious the Applicants claimed invention. The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the arts at the time of the applicant's invention to modify the teachings of Weinberg by incorporating recording the sequence of actions of the user in a member selection script" and "for the purpose of having a system that can save the user time since it can recreate the user's interactions and provide results without requiring the user's input each time the system is used", does not adequately address the issue of motivation to combine. (19 December 2006 Office Action, Page 5). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Gaflock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Weinberg or Schumacher, either individually or in combination.

**Examiner's response:**

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is not what individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Keller*, 648 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what

they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

Motivation for combining prior art references need not be explicitly found in references themselves, and examiner may provide explanation based on logic and sound scientific reasoning that will support holding of obviousness.

### **Examination Considerations**

8. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 105455, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

9. Examiner's Notes are provided with the cited references to prior art to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior



Art Unit: 2129

art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

10. Unless otherwise annotated, Examiner's statements are to be interpreted in reference to that of one of ordinary skill in the art. Statements made in reference to the condition of the disclosure constitute, on the face of it, the basis and such would be obvious to one of ordinary skill in the art, establishing thereby an inherent prima facie statement.

11. Examiner's Opinion: paragraphs 8-10 apply. The claims and only the claims form the metes and bounds of the invention. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2129

13. Claims 2-11, 13-21 and 23-31 are rejected.

***Correspondence Information***

14. Any inquires concerning this communication or earlier communications from the examiner should be directed to Omar F. Fernández Rivas, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-2589 or email [omar.fernandezrivas@uspto.gov](mailto:omar.fernandezrivas@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

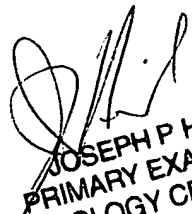
If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, David Vincent, may be reached at (571) 272-3080.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

Omar F. Fernández Rivas  
Patent Examiner  
Artificial Intelligence Art Unit 2129  
United States Department of Commerce  
Patent & Trademark Office

Wednesday, April 11, 2007

*OPR*

  
JOSEPH P. HIRL  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100